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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,597	07/24/2003	William Patrick Tunney	11884/404401	7932

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KENYON & KENYON LLP  
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SUITE 700  
WASHINGTON, DC 20005

EXAMINER
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PATEL, SHEFALI D

ART UNIT	PAPER NUMBER
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2624

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/625,597

Applicant(s)

TUNNEY, WILLIAM PATRICK

Examiner

Shefali D. Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. The amendment was received on December 12, 2006.
2. Claims 19-20 are newly added.
3. Double patenting rejection stands still because of the new similar amendment made also to the pending Application No. 10/625,659.

### *Response to Arguments*

4. Applicant's arguments filed under Remarks on pages 6-8 on December 12, 2006 have been fully considered but they are not persuasive.

Applicant argue on page 6 stating:

"Claim 1 as amended is directed to a method comprising, *inter alia*, "if portions of the capture data conflict, selecting the portion of the conflicting capture data that was captured last as the capture data." This advantageously provides the correct date to be stored in memory, even though the user may make a mistake in marking the date on the paper form and then correct the mistake, thereby causing a conflict in the capture data. Wolff does not teach or suggest how to resolve conflicts in data entry. Ericson does not bridge Wolff's gap because Ericson also fails to teach or suggest resolving conflicts in data entry. Therefore, claim 1 and its dependent claims 2 and 3 are believed to be patentable over the cited references, individually and in combination."

The examiner respectfully disagrees.

The applicant's arguments are flawed stating, "Wolff does not teach or suggest how to resolve conflicts in data entry." Wolff discloses this and teaches resolving conflicts in data entry at col. 6 line 4-30. The last captured data is entered if the user decides that is what the user is intended to do. If not, then the loop starts again and user enters new entry. This clearly resolves any conflicts that may occur.

The applicants state that "This advantageously provides the correct date to be stored in memory, even though the user may make a mistake in marking the date on the paper form and then correct the mistake." Wolff does resolve the conflicts in entry data. Yes, it might not be the date but it is the data entry that is being resolved if the conflict exists. Please keep in mind that the previous claim rejection

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was made under 35 U.S.C. 103(a) using Wolff in view of Ericson who discloses the calendar data in memory. Please see the rejection below.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 9-10, 14-15 and 17-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-7, 12-13 and 16-17, respectively of copending Application No. 10/625,659. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims recite “date” and the copending application recites “time”. The two are similar when it comes to its definition. Date is described as “the time or period to which any event or thing belongs” according to [www.dictionary.com](http://www.dictionary.com). Therefore, they are obvious over the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Dependent claims 11-16 are rejected for the same reasons.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-13 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff et al. (hereinafter, "Wolff") (US 6,081,261) in view of Ericson (US 6,666,376).

With regard to **claim 1** Wolff discloses a method comprising (Figures 1 and 5): receiving capture data from a capture device, wherein the capture data is captured simultaneously with writing made on a paper form (col. 3 lines 26-65, col. 7 lines 6-9 and col. 9 lines 44-46); if portions of the capture data conflict, selecting the portion of the conflicting capture data that was captured last as the capture data (col. 6 lines 4-30); comparing the capture data with one of a plurality of unique positions stored in memory in association with a plurality of calendar dates (col. 5 lines 22-26 and the calendar book information is disclosed at col. 3); retrieving from memory the calendar date associated with the unique position that matches the capture data (col. 5 lines 48-55 and lines 1-6). Wolff does not expressly disclose storing the retrieved calendar date in memory as the writing made on the paper form. Ericson discloses this at col. 7 lines 25-38 and also on col. 5 lines 29-39. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Ericson with Wolff. The motivation for doing so is to determine the unique time period, which identifies the first calendar area, thereby enabling the creation of an electronic back-up of the calendar as suggested by Ericson. Therefore, it would have been obvious to combine Ericson with Wolff to obtain the invention as specified in claim 1.

With regard to **claims 2 and 3** both Wolff and Ericson discloses the coordinates (x,y) and (x,y,t). Wolff at col. 7 lines 21-22, col. 8 lines 7-17, 26, 37 and 45. See, Ericson at col. 7 line 46.

**Claim 4** is rejected the same as claim 1. Thus, arguments similar to that presented above for claim 1 is equally applicable to claim 4. Claim 4 distinguishes from claim 1 only in that it recites the capture data representing positions of a set of marks made on paper overlaying a face of the capture device. Both Wolff and Ericson teach the position data and the code to recognize. See Wolff at col. 5 lines 1-30 and Ericson at col. 6 lines 40-65.

**Claims 5-6** recites identical features as claims 2-3. Thus, arguments similar to that presented above for claims 2-3 is equally applicable to claims 5-6.

With regard to **claim 7** Wolfe discloses the capture data captured simultaneously with the making of the set of marks on the paper (col. 2 lines 48-56, col. 4 lines 21-23).

With regard to **claim 8** Wolff discloses receiving a set of points from the capture device, the set of points representing orientation of the paper on the capture device; and determining the positions of the set of marks relative to the set of points (col. 8 lines 40-63).

**Claim 9** is rejected the same as claim 1. Thus, arguments similar to that presented above for claim 1 is equally applicable to claim 9. Claim 9 distinguishes from claim 1 only in that it recites mapping the set of coordinates to a data. Ericson discloses this at col. 6 lines 26-39 and line 66 to col. 7 line 20.

**Claim 10** is the same as claim 3 where the time was included in the vector.

With regard to **claim 11** Wolff discloses three groups of boxes, which includes months, days and one of the years at col. 3 lines 32-34.

With regard to **claim 12** Wolff discloses checking on box from each of the first, second and third groups. See element 13 in Figure 1, which is a code representing data (year, month and day). Figure 1 represents one page from the calendar book representing that day, date and time.

With regard to **claim 13** Wolff discloses resolving the checking of multiple boxes within one of the first, second, or third groups, including receiving multiple sets of coordinates corresponding to the

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multiple boxes, and determining which of the multiple sets of coordinates was captured by the capture device last (note, at col. 5 lines 31-36 knowing the index I sub k and the limits defining I sub k is how the beginning and end of the message is determined. Further disclosed at col. 5 lines 48-67).

With regard to **claim 16** Wolff discloses the paper data form attached to the capture device, the form including a calendar displaying the days in a month (see Figure 1). Ericson discloses this as seen in Figures 1 and 8.

**Claim 17** is rejected the same as claim 9 except claim 17 is a system claim. Thus, arguments similar to that presented above for claim 9 is equally applicable to claim 17. Note, Wolff discloses a memory and a processor along with a display as seen in Figure 5 and its respective portions in the specification.

**Claim 18** is the same as claim 3 where the where and when was included in the vector (i.e., x,y,t).

**Claim 19** is rejected the same as claims 1 and 4. Thus, arguments similar to that presented above for claims 1 and 4 are equally applicable to claim 19.

**Claim 20** is rejected the same as claim 18. Thus, arguments similar to that presented above for claim 18 are equally applicable to claim 20.

#### *Allowable Subject Matter*

9. Claims 14-15 are objected to as being dependent upon a rejected base claim (Double Patenting Rejection), but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and this Double Patenting Rejection is resolved.

The reasons for allowance are disclosed in an Office Action mailed on September 26, 2006 and the reasons are not repeated herein, but are incorporated by reference.

*Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shefali D. Patel whose telephone number is 571-272-7396. The examiner can normally be reached on M-F 8:00am - 5:00pm (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella can be reached on (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

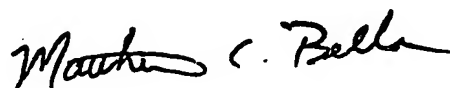


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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